

REMARKS

The Office Action mailed September 10, 2009 has been carefully considered by Applicant. Reconsideration is respectfully requested in view of the foregoing amendments to the claims and the remarks that follow.

Drawing Objections

The claims are amended to remove the "substantially cylindrical center portion". As such, the objection to the drawings is believed rendered moot.

Claim Rejections Under 35 U.S.C. §112, First Paragraph

Claims 9-28 have been rejected as failing to comply with the enablement requirement. Claims 9-28 are rejected as failing to comply with the written description requirement. By the present Amendment, claims 9-28 are cancelled and replaced with new claims 29-40. New claims 29-40 do not include the claim limitations causing the rejections under Section 112, first paragraph. As such, withdrawal of these rejections is appropriate and requested.

Claim Rejections Under 35 U.S.C. §103

Claims 9-12 have been rejected as being obvious over Yarnell et al U.S. Patent No. 5,967,454 in view of Salloum U.S. Patent No. 5,004,179 and Zuk et al U.S. Patent No. 5,791,590. Claims 13-16 and 19 have been rejected as being obvious over Yarnell et al '454 in view of Salloum '179 and Zuk et al '590, and further in view of Faulkner U.S. Patent No. 5,474,254. Claim 17 has been rejected as being obvious over Yarnell et al '454 in view of Salloum '179 and Zuk et al '590, and further in view of Dobson U.S. Patent No. 819,866. Claim 18 has been rejected as being obvious over Yarnell et al '454 in view of Salloum '179 and further in view of Zuk et al '590 and Campbell U.S. Patent No. 3,940,085. Claims 20-23 have been rejected as being obvious over Yarnell et al '454 in view of Salloum '179 and Zuk et al '590. Claims 24-28 have been rejected as being

obvious over Yarnell et al '454 in view of Salloum '179 and Zuk et al '590, and further in view of Faulkner '254.

Claims 9-28 are cancelled and replaced with new claims 29-40. New claims 29-40 more particularly point out and distinctly claim the subject matter of the invention and are believed allowable over the cited references.

In the "Response to Arguments" section, paragraph 31, the Examiner states:

The "teaching" of having different diameters is considered provided by Zuk.

Regarding applicant's argument about the Zuk reference (see page 8, lines 16-27 of remarks). The examiner considers the core 16 of Zuk (see figures 5-6) capable of being able to form a substantially cylindrical center portion. Such a teaching of segments forming a core of different diameters is obvious because reversing the connection of the flaps 36 and tabs 38 to the grooves 26 and 28 (compared to the connection shown in figure 6) would provide a substantially cylindrical center portion of a different radius. (emphasis added)

This is incorrect. The outer groove 38 of Zuk forms an opening for receiving flap 36. The inner groove 26 is used for locking of the tabs 38. Zuk states:

The new and improved reel of the subject invention is assembled by placing the hub on one side of a flange, urging the flaps adjacent the flange through an outer set of grooves, folding the flaps and urging the semi-circular tabs through the inner set of grooves. This process is then repeated for the second flange. Once assembled, the reel can be mounted onto a drive shaft or other drive apparatus for take-up of a carrier tape. See column 3, lines 31-39.

The Examiner's statement that Zuk is "capable of being able to form a substantially cylindrical center portion" and the Examiner's proposed modification of the teaching of Zuk to provide "reversing the connection of the flaps 36 and tabs 38" is **unsupported and based entirely in hindsight**. The fact is that Zuk '590, along with the rest of the prior art cited by the Examiner in this application do not teach or suggest the claimed *opposing end flanges that are separably connectable to the inner cylindrical*

center portion and to the outer cylindrical center portion, wherein the respective center portions have different diameters.

The modification proposed by the Examiner would require resizing of the slots 26, 28. This modification is certainly not taught by Zuk. In fact, the proposed modification would render Zuk inoperable, as the tabs 38 are not sized to engage with the larger slots 28 in the manner suggested by the Examiner. If a reference that is taken in combination would produce a "seemingly inoperative device" it is consistently held that such a combination actually teaches away from the claimed combination and cannot serve as a predicate for *prima facie* obviousness. See McGinley v. Franklin Sports Inc., 262 F.3d 1339, 60 USPQ 2d 1001, 1010 (Fed. Cir. 2001).

It has also been consistently held that a suggestion to combine references cannot require substantial reconstruction or redesign of the prior art. Here, the Examiner's suggested combination of references would require a substantial reconstruction and redesign of the elements shown in Zuk, as well as a change in the basic principles under which the Zuk construction was designed to operate. Courts have consistently held that this sort of hindsight combination is not sufficient to support a *prima facie* case of obviousness. See e.g. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The remaining references cited by the Examiner do not fill the gap left by Zuk.

Claim 29 is thus believed in condition for allowance. Such action is respectfully requested.

Claims 30-40

Claims 30-40 depend directly or indirectly from claim 29 and are believed allowable for the reasons stated above, as well as the subject matter recited therein.


Application No. 10/595,342
Amendment Dated November 25, 2009
Reply to Office Action of September 10, 2009

Conclusion

The present application is thus believed in condition for allowance. Such action is respectfully requested.

Respectfully submitted,

ANDRUS, SCEALES, STARKE & SAWALL, LLP

By 
Peter T. Holsen
Reg. No. 54,180

Andrus, Sceales, Starke & Sawall, LLP
100 East Wisconsin Avenue, Suite 1100
Milwaukee, Wisconsin 53202
Telephone: (414) 271-7590
Facsimile: (414) 271-5770